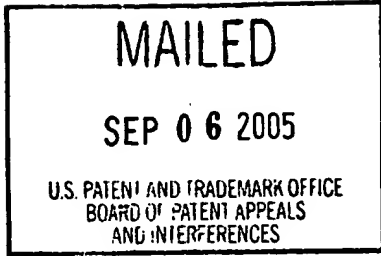


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY E. MARTINEZ and MICHAEL D. RAHN

Application 09/981,905

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences (BPAI) on August 12, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellant filed an Appeal Brief on October 29, 2004. Attention is drawn to the fact that the Rules of Practice before the Board of Patent Appeals and Interferences changed effective September 13, 2004.¹

The Appeal Brief is not in compliance with 37 CFR § 41.37(c)(1).

37 CFR § 41.37(c)(1) states in part:

¹ The new rules are set forth at 69 Federal Register 49960, which may be accessed via the internet at <http://www.uspto.gov/web/offices/com/sol/notices/69fr49960.pdf>.

(c)(1) The brief will contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section . . . :

. . .

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The SUMMARY OF CLAIMED SUBJECT MATTER in the brief does not appear to comply with the requisite explanation as outlined in paragraph (v) above. A more detailed *Summary of claimed subject matter* is required.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner . . .

The heading 10. CLAIMS APPENDIX in the brief contains information relating to paragraph (ix) above and it is assumed that it was intended to be titled 10. EVIDENCE APPENDIX.

Correction is required.

Additionally, appellants' brief contains a heading 7. GROUPING OF CLAIMS.

This heading and the information relating to it should be removed from the brief as 37 CFR § 41.37 no longer requires it, and stipulates claim grouping should be addressed in § 41.37(c)(vii) *Argument* as follows: “. . . Claims argued as a group should be placed under a subheading identifying the claims by number.”

37 CFR § 41.37(d) states:

(d) If a brief is filed which does not include all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

As per the above, a substitute brief that is in compliance with all of § 41.37(c) is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

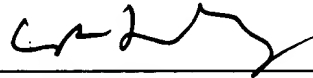
1) to hold the Appeal Brief filed October 29, 2004, defective and notification to appellant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37,

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- 2) for consideration of the substitute Appeal Brief, to vacate the Examiner's Answer mailed April 5, 2005, and issue a revised Examiner's Answer in accordance with the new rules effective September 13, 2004, and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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